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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,269	04/09/2001	Albert J. Sturm JR.	P19.12-0036	8135

7590 01/25/2005
Steven M. Koehler
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EXAMINER

JIMENEZ, MARC QUEMUEL

ART UNIT PAPER NUMBER

3726

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/829,269

Applicant(s)

STURM ET AL.

Examiner

Marc Jimenez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-21 and 53-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-20, 53, 54, 57 and 58 is/are rejected.
- 7) ☒ Claim(s) 21, 55, 56 and 59-63 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 07092002, 03272002.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group II, Claims 12-21 in the reply filed on 11/1/04 is acknowledged.
2. Claims 1-11 and 22-52 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant has canceled the non-elected claims 1-11 and 22-52 in the amendment filed 11/18/04.

Information Disclosure Statement

3. The references lined thru in the PTO-1449 have not been received. Applicant is requested to submit copies of these references for consideration.

Specification

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed (ie. the elected apparatus claims).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 12, 16 and 17** are rejected under 35 U.S.C. 102(b) as being anticipated by Challberg et al. (US 5,624,047).

Challberg et al. teach a damping structure comprising a plurality of overlapping segments **6f,g** (figure 4) forming at least a portion of a housing **6g** and having a plurality of fastening regions **32** spaced apart about the housing **6g** with damping (col. 7, line 5) material **28,30** disposed between the segments **6f,g**.

Regarding claims 16 and 17, the damping material is made of polyethylene (col. 6, line 35) which is a viscoelastic damping material.

7. **Claims 12-18, 20, 53, 54, 57, and 58** are rejected under 35 U.S.C. 102(b) as being anticipated by Sibel (FR 2,659,259).

Sibel teaches a damping structure comprising a plurality of overlapping segments **3** forming at least a portion of a housing **3,4** and having a plurality of fastening regions spaced apart about the housing with damping material **4** disposed between the segments **3**.

Regarding claims 13, 53, and 54, note the rigid plate **1** secured to the housing **4,3** and wherein the housing **4,3** is U-shaped. Also, in figure 8, there is a square element attached to the housing which could also be considered a rigid plate.

Regarding claims 14-15, note the flanges **2** for fastening the housing **4,3** to the rigid plate **1**. Note also that in figures 3-6, there are also elements that could be considered flanges with bolt holes attached to various areas of the housing.

Regarding claims 16-17, the damping material **4** is viscoelastic (abstract, line 9) joined to the segments **3**.

Regarding claim 18, see figure 8 where there are linear bearings secured to the rigid plate (the square plate attached to the housing in figure 8).

Regarding claim 20, note that the ribs **2** are also considered overtravel stops limiting relative movement of overlapping segments **3**.

Regarding claims 57-58, note the rails (see below the reference character "x" in figure 10) and supports (see the four supports in figure 10 attached to the ground) for supporting the rails. Note the trucks in figures 7-8.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claim 19** is rejected under 35 U.S.C. 103(a) as being unpatentable over Sibel.

Sibel teaches that the U-shaped housing and the linear bearings are secured on opposite sides of the rigid plate (see figure 8).

Sibel does not specifically teach that fasteners are used that pass through apertures in the rigid plate to secure the linear bearings and U-shaped housing to the rigid plate.

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However, official notice is taken that it was well known to a person of ordinary skill in the art, at the time of the invention, to have used fasteners, since the use of fasteners will securely fasten parts together.

Allowable Subject Matter

10. **Claims 21, 55, 56, and 59-63** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Contact Information

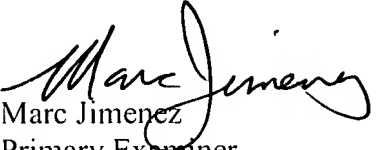
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number (571) 272-4530. The examiner can normally be reached on Monday-Friday between 5:30 a.m.-2:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 273-4530. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Marc Jimenez
Primary Examiner
Art Unit 3726

MJ

January 24, 2005